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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,021	09/05/2003	Makarand P. Gore	200312226-1	8140

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

LE, HOA VAN

ART UNIT PAPER NUMBER

1752

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/656,021	Applicant(s) GORE, MAKARAND P. ef	
	Examiner Hoa V. Le	Art Unit 1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-19 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

This application is up for consideration.

A. In view of the complexity of the broad claims as set up this Office action is made.

B. For the claims only, the disclosure in the claims shows that applicant and its counsel could be able to comprehend and properly use, apply, disclose and claim a proper language

(1) between "compound" and "composition". A "compound" as claimed is considered and searched only.

(2) "derivative" is not a positive or exact in a practice before the Office. It is not considered or searched.

(3) "precursor" is not a positive or exact in a practice before the Office. It is not considered or searched.

(3) "optionally..." is not required. It is not considered or searched.

A consideration and search will be applied to a positive and exact language, term and chemical structure as comprehended and as required before the Office only. It is now notified for the record.

C.1. Claims 1-19 are generic to a plurality of disclosed patentably distinct species comprising many possible chemical ingredients of matrixes as broadly disclosed in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed chemical ingredient species of matrixes

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for an initiation of a search, even though this requirement is traversed. Applicant is requested and required to show or provide the exact chemical structure of the elected chemical ingredient species by showing all bonding connections between and among chemical elements and positions of all chemical elements in the structure for an exact consideration and search. No further examination will be made until the request and requirement are met. It is set forth and notified for the record.

2. Claims 1-19 are generic to a plurality of disclosed patentably distinct species comprising many possible chemical ingredients of antennas, their precursors and derivatives as broadly disclosed in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed chemical ingredient species of antennas and their precursor and derivatives for an initiation of a search, even though this requirement is traversed. Applicant is requested and required to show or provide the exact chemical structure of the elected chemical ingredient species by showing all bonding connections between and among chemical elements and positions of all chemical elements in the structure for an exact consideration and search. No further examination will be made until the request and requirement are met. It is set forth and notified for the record.

***Applicant is further requested and required to identified the elected chemical structure antenna is either (1) infrared radiation or (2) laser radiation absorption. No further examination will be made until the request and requirement are met. It is set forth and notified for the record.

3. Claims 1-19 are generic to a plurality of disclosed patentably distinct species comprising many possible chemical ingredients of color formers as broadly disclosed in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed chemical ingredient species of color formers for an initiation of a search, even though this requirement is traversed. Applicant is

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requested and required to show or provide the exact chemical structure of the elected chemical ingredient species by showing all bonding connections between and among chemical elements and positions of all chemical elements in the structure for an exact consideration and search. No further examination will be made until the request and requirement are met. It is set forth and notified for the record.

4. Claims 1-19 are generic to a plurality of disclosed patentably distinct species comprising many possible chemical ingredients of activators as broadly disclosed in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed chemical ingredient species of activators for an initiation of a search, even though this requirement is traversed. Applicant is requested and required to show or provide the exact chemical structure of the elected chemical ingredient species by showing all bonding connections between and among chemical elements and positions of all chemical elements in the structure for an exact consideration and search. No further examination will be made until the request and requirement are met. It is set forth and notified for the record.

5. Claims 1-19 are generic to a plurality of disclosed patentably distinct species comprising many possible chemical ingredients of antennas as broadly disclosed in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed chemical ingredient species of antennas for an initiation of a search, even though this requirement is traversed. Applicant is requested and required to show or provide the exact chemical structure of the elected chemical ingredient species by showing all bonding connections between and among chemical elements and positions of all chemical elements in the structure for an exact consideration and search. No

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further examination will be made until the request and requirement are met. It is set forth and notified for the record.

6. Claims 1-19 are generic to a plurality of disclosed patentably distinct species comprising many possible chemical ingredients of other color formers as broadly disclosed in the art.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed chemical ingredient species of other color formers for an initiation of a search, even though this requirement is traversed.

Applicant is requested and required to show or provide the exact chemical structure of the elected chemical ingredient species by showing all bonding connections between and among chemical elements and positions of all chemical elements in the structure for an exact consideration and search. No further examination will be made until the request and requirement are met. It is set forth and notified for the record.

7. Claims 1-19 are generic to a plurality of disclosed patentably distinct species comprising many possible chemical ingredients of other activators as broadly disclosed in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed chemical ingredient species of other activators for an initiation of a search, even though this requirement is traversed. Applicant is requested and required to show or provide the exact chemical structure of the elected chemical ingredient species by showing all bonding connections between and among chemical elements and positions of all chemical elements in the structure for an exact consideration and search. No further examination will be made until the request and requirement are met. It is set forth and notified for the record.

8. Claims 1-19 are generic to a plurality of disclosed patentably distinct species comprising many possible chemical ingredients of binders as broadly disclosed in the art. Applicant is

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required under 35 U.S.C. 121 to elect a single disclosed chemical ingredient species of binders for an initiation of a search, even though this requirement is traversed. Applicant is requested and required to show or provide the exact chemical structure of the elected chemical ingredient species by showing all bonding connections between and among chemical elements and positions of all chemical elements in the structure for an exact consideration and search. No further examination will be made until the request and requirement are met. It is set forth and notified for the record.

9. Claims 1-19 are generic to a plurality of disclosed patentably distinct species comprising many possible chemical ingredients of dyes as broadly disclosed in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed chemical ingredient species of dyes for an initiation of a search, even though this requirement is traversed. Applicant is requested and required to show or provide the exact chemical structure of the elected chemical ingredient species by showing all bonding connections between and among chemical elements and positions of all chemical elements in the structure for an exact consideration and search. No further examination will be made until the request and requirement are met. It is set forth and notified for the record.

10. Claims 1-19 are generic to a plurality of disclosed patentably distinct species comprising many possible chemical ingredients of color develops as broadly disclosed in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed chemical ingredient species of color developers for an initiation of a search, even though this requirement is traversed. Applicant is requested and required to show or provide the exact chemical structure of the elected chemical ingredient species by showing all bonding connections between and among chemical elements

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and positions of all chemical elements in the structure for an exact consideration and search. No further examination will be made until the request and requirement are met. It is set forth and notified for the record.

11. Claims 1-19 are generic to a plurality of disclosed patentably distinct species comprising many possible chemical ingredients of antennas as broadly disclosed in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed chemical ingredient species of antennas for an initiation of a search, even though this requirement is traversed. Applicant is requested and required to show or provide the exact chemical structure of the elected chemical ingredient species by showing all bonding connections between and among chemical elements and positions of all chemical elements in the structure for an exact consideration and search. No further examination will be made until the request and requirement are met. It is set forth and notified for the record.

12. Claims 1-19 are generic to a plurality of disclosed patentably distinct species comprising many possible chemical ingredients of other dyes as broadly disclosed in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed chemical ingredient species of other dyes for an initiation of a search, even though this requirement is traversed. Applicant is requested and required to show or provide the exact chemical structure of the elected chemical ingredient species by showing all bonding connections between and among chemical elements and positions of all chemical elements in the structure for an exact consideration and search. No further examination will be made until the request and requirement are met. It is set forth and notified for the record.

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13. Claims 1-19 are generic to a plurality of disclosed patentably distinct species comprising many possible chemical ingredients of other color developers as broadly disclosed in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed chemical ingredient species of antennas for an initiation of a search, even though this requirement is traversed. Applicant is requested and required to show or provide the exact chemical structure of the elected chemical ingredient species by showing all bonding connections between and among chemical elements and positions of all chemical elements in the structure for an exact consideration and search. No further examination will be made until the request and requirement are met. It is set forth and notified for the record.

14. Claims 1-19 are generic to a plurality of disclosed patentably distinct species comprising many possible chemical ingredients of solvents as broadly disclosed in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed chemical ingredient species of solvents for an initiation of a search, even though this requirement is traversed. Applicant is requested and required to show or provide the exact chemical structure of the elected chemical ingredient species by showing all bonding connections between and among chemical elements and positions of all chemical elements in the structure for an exact consideration and search. No further examination will be made until the request and requirement are met. It is set forth and notified for the record.

15. Claims 1-19 are generic to a plurality of disclosed patentably distinct species comprising many possible chemical ingredients of color initiators as broadly disclosed in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed chemical ingredient species of color initiators for an initiation of a search, even though this requirement is traversed. Applicant is

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requested and required to show or provide the exact chemical structure of the elected chemical ingredient species by showing all bonding connections between and among chemical elements and positions of all chemical elements in the structure for an exact consideration and search. No further examination will be made until the request and requirement are met. It is set forth and notified for the record.

16. Claims 1-19 are generic to a plurality of disclosed patentably distinct species comprising many possible chemical ingredients of color changing dyes as broadly disclosed in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed chemical ingredient species of color changing dyes for an initiation of a search, even though this requirement is traversed. Applicant is requested and required to show or provide the exact chemical structure of the elected chemical ingredient species by showing all bonding connections between and among chemical elements and positions of all chemical elements in the structure for an exact consideration and search. No further examination will be made until the request and requirement are met. It is set forth and notified for the record.

17. Claims 1-19 are generic to a plurality of disclosed patentably distinct species comprising many possible chemical ingredients of other color initiators as broadly disclosed in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed chemical ingredient species of other color initiators for an initiation of a search, even though this requirement is traversed. Applicant is requested and required to show or provide the exact chemical structure of the elected chemical ingredient species by showing all bonding connections between and among chemical elements and positions of all chemical elements in the structure for an exact

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consideration and search. No further examination will be made until the request and requirement are met. It is set forth and notified for the record.

18. Claims 1-19 are generic to a plurality of disclosed patentably distinct species comprising many possible chemical ingredients of other color changing dyes solvents as broadly disclosed in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed chemical ingredient species of other color changing dyes for an initiation of a search, even though this requirement is traversed. Applicant is requested and required to show or provide the exact chemical structure of the elected chemical ingredient species by showing all bonding connections between and among chemical elements and positions of all chemical elements in the structure for an exact consideration and search. No further examination will be made until the request and requirement are met. It is set forth and notified for the record.

19. Claims 10-19 are generic to a plurality of disclosed patentably distinct species comprising many possible types of substrates as broadly disclosed in the art. Applicant is required under 35 U.S.C. 121 to elect a single disclosed substrate species of solvents for an initiation of a search, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

D. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5, drawn to an imaging compound, classified in class 430, at least subclass 11.
- II. Claims 6-9, drawn to an imaging material preparing process, classified in class 430, at least subclass 327.
- III. Claims 10-16, drawn to an imaging recording medium, classified in class 430, at least subclass 496.
- IV. Claims 17- 19, drawn to an imaging means, classified in class 396, at least subclass 225+. If applicant elect this invention, the application will be transferred to be examined in a different Technical Center.

The inventions of Groups I, III and IV are all related to the materials but have the patentably different and distinct and have acquired the separate status and searches in the art and can be supported the separate patents as divided by applicants and have no evidence on the record that is not required the separate consideration and search since they are the obvious variants because the prior art being applied to one of them would be sufficient against all inventions, restriction for examination purposes as indicated is proper. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

Because these inventions are distinct for the reasons given above and have acquired the separate status and searches in the art and can be supported the separate patents as divided by applicants and have no evidence of the record that are not required the separate consideration and search since they are the obvious variants because the

prior art being applied to one of them would be sufficient against all inventions, restriction for examination purposes as indicated is proper. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

E An additional consideration or search for more than one invention, class or subclass in the art is burdensome, lacks of focus on many and all issues in the claimed inventions and dilutes patentability of many and all issues in many inventions than those in one. Applicant should show or provide an evidence to the contrary. In the absence of convincing evidence, the restriction would not be removed.

F Applicant is advised that the reply to this requirement to be complete must include an election as set forth on the record to be examined even though the requirement be traversed (37 CFR 1.143).

G However any process claim is permitted to be rejoined with an elected material claimed Invention provided (a) that the material claimed invention is allowable and (b) the process claim must be contained all of the limitations of the allowable material claim in accordance with the authority stated in In re Ochiai, 37 USPQ2d 1127 or In re Brouwer, 37 USPQ2d 1663 and MPEP 821.04.

H Other issues have not been considered until a proper election is made and resolved all of the requirements as clearly pointed out and set forth above.

I. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:00 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306,

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
06 August 2004

HOA VAN LE
PRIMARY EXAMINER

